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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/860,007	08/04/97	BERSCHIED	R 62-209-45694

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12M2/1003

EXAMINER
PUTTLITZ, K

ART UNIT	PAPER NUMBER
1204	

DATE MAILED: 10/03/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/860,007

Applicant(s)
Berscheid et al.

Examiner
Karl J. Puttlitz Jr.

Group Art Unit
1204



☒ Responsive to communication(s) filed on Aug 4, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-12 is/are pending in the applicat

Of the above, claim(s) 3 and 11 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, 4, 6-8, and 12 is/are rejected.

☒ Claim(s) 5, 9, and 10 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1204

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 (formula I), 2-10 and 12, drawn to compounds of formula I, compositions, process of making and methods of use.

Group II, claim(s) 1 (formula II) and 11, drawn to drawn to compounds of formula II, and process of making.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Compounds of formulas I and II are patentably distinct compounds and do not have a technical relationship involving one or more of the same or corresponding special technical features. By virtue of the fact that the compound genres are known, the inventions do not share a technical feature that defines a contribution which the inventions, considered as a whole, makes over the prior art .

Art Unit: 1204

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Compounds of claims 2, 3, and 5.

Compound of claim 5, (+/-)-2-(3-chlorobenzyl) butanol.

Applicant is required, in response to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The response must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

Art Unit: 1204

By virtue of the fact that the compound genres are known, the inventions do not share a technical feature that defines a contribution which the inventions, considered as a whole, makes over the prior art .

5. During a telephone conversation with Jeffery S. Melcher on 9/23/97 a provisional election was made with traverse to prosecute the invention of Group I, claims 1,2,4,5,6-10 and 12; and elected the compound of claim 5 as a species. Affirmation of this election must be made by applicant in responding to this Office action. Claims 3 and 11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Claim Rejections - 35 USC § 112

7. Claims 1, 2, 4, 6-10 and 12 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1204

8. Claims 1, 2, 10 and 12 recite R^1 as being a significance of R^2 . It is unclear as what applicant is referring to as "significance". The term "significance" is indefinite and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

9. Claim 12 provides for the use of compounds of formula I, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. The claim also does not set forth a statutory class of invention (e.g. method of use). See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1204

11. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by each of Miller et al. (U.S. Pat. No. 4118461), Buschmann et al. (U.S. Pat. No. 4472412), and Manabe et al. (Agric. Biol. Chem. (1986), 50(12), 3215-17).

Miller et al. (U.S. Pat. No. 4118461) discloses a compound which is 2-(2,4-dichlorophenyl)hexane-1-ol (column 14, line 58; also see Registry File Abstract).

Buschmann et al. (U.S. Pat. No. 4472412) discloses a compound which is a 2-(4-chlorophenyl)hexane-1-ol (see Registry File Abstract).

Manabe et al. (Agric. Biol. Chem. (1986), 50(12), 3215-17) teaches a compound which is 2-(2,4-dichlorophenyl)-3,3-dimethylpropane-1-ol (see Registry File Abstract).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. (U.S. Pat. No. 4118461).

Claims 6-8 are drawn to compositions containing compounds of formula I. However, Miller et al. teaches compounds within the scope of formula I. It would have been obvious to one having ordinary skill at the time of the invention to incorporate compounds in a composition since

Art Unit: 1204

the practitioner can readily envision compounds of formula I in solution of water and/or alcohols or in admixture with alcoholic impurities. It is held that the incorporation of known compounds into suitable solvents to obtain solutions consistent with the teachings of the prior art would have been obvious to one of ordinary skill.

Allowable Subject Matter

14. Claims 9, and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The elected compound of claim 5, (+/-)-2-(3-chlorobenzyl) butanol, is found to be allowable but is objected to as being dependent upon rejected claim 1.

Conclusion

16. Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Karl J. Puttlitz whose telephone number is (703) 305-1869. The Examiner's normal tour of duty is Monday-Friday, 8:30 AM to 5:30 PM. Any inquiry of a general nature should be directed to the Group 1200 receptionist whose telephone number is (703) 308-1235. The Examiner's supervisor, Gary Geist, may be reached at (703) 308-1701.

Serial Number: 08/860007


Page 8

Art Unit: 1204

Communications may now be transmitted via fax directly to Group 1200. The official Group 1200 fax machine number is (703) 308-4556.

Karl J. Puttlitz,

Art Unit: 1204


SAMUEL BARTS
PRIMARY EXAMINER
GROUP 1200